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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,240	01/07/2000	Michel H. Klein	1038-1000 MIS	2813

7590 07/29/2003

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EXAMINER

NAVARRO, ALBERT MARK

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/479,240

Applicant(s)

Klein et al

Examiner

Mark Navarro

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1645



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Mar 10, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Mar 10, 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other:

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ADVISORY ACTION

Applicant's request for reconsideration filed March 10, 2003 (Paper Number 14) has been received and entered. Consequently claims 59, 61-70, and 72-74 are pending in the instant application.

Specification

1. The objection of the amendment filed January 7, 2000 under 35 U.S.C. 132 because it introduces new matter into the disclosure is maintained. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Applicant's have amended the sequence in Figure 5 to recite a new nucleotide sequence at positions 540 and 630, and have further changed the resulting amino acid at the position corresponding to site 630 of the nucleic acid sequence. Each of these changes are deemed new matter.

Applicant's are asserting that this application is a continuation of 08/467,960, filed June 6, 1995, which is a division of application number 08/001,554 filed January 6, 1993, and that this application further claims priority from GB 9200117.1. Applicant's assert that Figure 5 of the priority GB application shows the nucleotide and derived amino acid sequence for the RSV F gene in its correct version. Applicants further assert that since priority is claimed under 35 USC 119 from the GB application, its contents are incorporated into the specification. Applicant's

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further assert that Applicant's GenBank submission of the RSV F gene in September 1993 of the correct sequence, provides further evidence that the sequence recited in the instantly filed application was merely a typographical error.

Applicant's arguments have been fully considered but are not found to be fully persuasive.

Applicant's arguments are not found to be fully persuasive in view of MPEP 608, which sets forth that "All amendments or claims must find descriptive basis in the original disclosure, or they involve new matter. Applicant may rely for disclosure upon the specification with original claims and drawings, as filed." No provision is made for foreign priority documents or submissions to GenBank. As to Applicants statement that since priority is claimed under 35 USC 119, its contents are incorporated into the specification is simply incorrect. Applicants could just as easily discovered a sequence error in the foreign priority document and corrected them for the filing of the US application. Incorporation is not automatically bestowed unless specifically recited. Consequently, the changes are deemed new matter.

Consequently, the objection to the specification is maintained for reasons of record.

Claims 59, 61-70 and 72-74 are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Navarro, whose telephone number is (703) 306-3225. The examiner can be reached on Monday - Thursday from 8:00 AM - 6:00 PM. The examiner can be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Lynette Smith can be reached at (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1645 by facsimile transmission. Papers should be faxed to Group 1645 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the official Gazette 1096 OG 30 (November 15, 1989). The CMI Fax Center number is (703) 308-4242.



Mark Navarro

Primary Examiner

July 29, 2003